

REMARKS

I. Status of the Application

Claims 1-35 were filed in the original application, and claims 1-35 were examined in the Office Action.

In the Office Action, the Examiner: (1) objected to claims 20 and 21 because the Examiner asserted that it is unclear if the "secondary document" referred to in the claims is the same as the "secondary document" mentioned in claims 3 and 4; (2) rejected claims 11, 26, and 27 under 35 U.S.C. § 112 as failing to comply with the enablement requirement; (3) rejected claims 1, 2, 5-10, 12, 17, 18, 22-25, 28-31, and 33-35 under 35 USC § 102(b) as being anticipated by Burakoff et al. (U.S. Publ. No. 2002/0065896); (4) rejected claims 3, 4, 20, and 21 under 35 USC § 103(a) as being unpatentable over Burakoff et al. in view of Bosarge et al. (U.S. Publ. No. 2003/0191689); and (5) rejected claims 13-16, 19, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Burakoff et al. in view of website www.tdcanadatrust.com (hereinafter "TD Canada Trust").

In this response, the Applicant respectfully cancels claims 11 and 26, amends claims 1, 3, 27, and 34, and claims 2-10, 12-25, 28-33, and 35 remain in the application.

II. No New Matter Is Introduced by Way of Amendment

Claims 1 and 34 have been amended to require that the investor document comprises "a plurality of parts with each of the plurality of parts defined with a trade identifier", and that the termination of required investment information performed by the process is "made by the use of the trade identifier of each of the plurality of parts of each of the identified document(s)". This requirement is supported in the specification throughout the specification, including at paragraph

64, and in claims 11 and 26 as originally filed. Claim 3 has been amended to require that the processor be programmed to "retrieve a secondary document". This requirement is supported in the specification at Paragraph 80, and also in claim 21 as originally filed. Claim 27 has been amended to change the word "code" to "trade identifier", which is supported in the specification at Paragraph 64. Therefore, no new matter has been introduced by way of amendment.

III. The Objection to Claims 20 and 21 is Overcome

Claims 20 and 21 were objected to because the Examiner stated that it is unclear whether the secondary document referred to in the claim is the same as the secondary document mentioned in claims 3 and 4. Claim 3 has been amended to require that "the processor is further programmed to retrieve a secondary document". Claims 3 and 21 both depend from and include the limitations of claim 1, and also both include the limitation that the processor be programmed to retrieve secondary documents. Claim 4 depends from and includes all the limitations of claim 3, as amended, and claim 21 depends from and includes all the limitations of claim 20.

The term "secondary document" is defined in the specification. Specifically, at page 22, lines 9 to 14, it is stated,

As use herein and in the claims, "secondary documents" means documents or data that does not comprise compliance documents or data, and maybe included in the investor information. In addition to cover letter 508 and back cover 515 illustrated in Figure 7, secondary documents may include artwork, advertisements, trade confirmations, disclaimers, or other forms of communication desired to be provided to the investor.

Thus, based on the amendment to claim 3 to be in concert with claim 21, and the defined term of "secondary documents", there should be no question that the secondary documents referred to in

claims 20 and 21. For this reason, it is respectfully submitted that the Examiner's objection to claims 20 and 21 is overcome.

IV. The Rejection of Claims 11, 26, and 27 Under 35 U.S.C. § 112 is Overcome

Claims 11, 26, and 27 were rejected under 35 U.S.C. § 112 as failing to comply with the enablement requirement. Specifically, the Examiner stated that claims 11, 26, and 27 "refer to a code, which is not clearly defined in the specification. Applicant refers to a Java code and a security code in the specification. It is not clear which one (or some other) is being referred to in the claim language". Office Action, page 2.

Claims 11 and 26 have been cancelled. Claim 1, as amended, and upon which claim 27 depends, requires that "each of the plurality of parts" of an investor document be "defined with a trade identifier", and "the processor uses such trade identifiers in determination of the required investment information". Claim 26 has been amended to change the reference to "code(s)" to "trade identifier(s)".

The Examiner was not clear what "code" was claimed in claims 11, 26, and 27. With regard to "trade identifiers", the Examiner is directed toward Paragraph 64 of the specification, where it is stated

At step 309, each document part identified by segmentation step 308 is associated with an identifier used in the daily transactions. To perform this function, trade identifiers database 310 is accessed by the system. Trade identifiers database 310 may be maintained by the operator of the system of the present invention or by a third party. For example, in Canada, FundSERV codes are typically used to identify mutual funds in transactions, while the CUSIP identifying system is used for other securities. Alternately, a data repository comprising a numbering scheme for identity of a type or types of securities may be used and made available for access by the system of the present invention.

By amendment of claims 1 and 27 to use the term "trade identifier" rather than "code", it is respectfully submitted that claim 27 is allowable, and the Examiner's rejection of claim 27 under 35 U.S.C. § 112 as failing to comply with the enablement requirement is overcome.

V. The Rejection of Claims 1, 2, 5-10, 12, 17, 18, 22-25, 28-31, and 33-35 Under 35 U.S.C. § 102(b) as Anticipated by Burakoff et al. is Overcome

Claims 1, 2, 5-10, 12, 17, 18, 22-25, 28-31, and 33-35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Burakoff et al. A rejection under 35 U.S.C. § 102(b) can be overcome by "persuasively arguing that the claims are patentably distinguishable from the prior art." MPEP § 706.02(b). A prior art patent, publication, or event is for the same "invention," as that word is used in 35 U.S.C. § 102, and therefore anticipating, if the prior art patent, publication or event discloses each and every limitation found in the claims, either expressly or inherently. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Each claim limitation must be found in a single prior art reference; references cannot be combined under 35 U.S.C. § 102. *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760 (Fed. Cir. 1983). "[A] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131.01. ***Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on 35 U.S.C. § 102.*** *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983). Where a reference is alleged to inherently disclose a claim element, the missing element must necessarily be present in the cited reference

and that it be so recognized by those of skill in the art. It is not enough that the missing element is possibly or probably present. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

Claim 1 Is Not Anticipated by Burakoff et al.

Claim 1, as amended, now includes further limitations with regard to the investor documents and selection thereof to be provided to an investor. Specifically, "each of the at least one investor documents" now comprises "a plurality of parts with each of the plurality of parts defined with a trade identifier". Also, the processor, when determining the "required investment information for the investor from the identified document(s)", makes such determination "by use of the trade identifier of each of the plurality of parts of each of the identified document(s)". In this manner, the present invention provides several advantages. As set forth in Paragraph 22 of the specification:

The present invention provides a mechanism for the custom generation of this compliance information in a manner that allows an investment dealer to provide the investor with only the most up to date required information. In one embodiment of the present invention, *a package generated upon the purchase of one or more mutual fund securities contains, all in the investor's language of choice, a cover letter; a trade confirmation for each mutual fund purchase made on the same day though the dealer, consolidated by the appropriate account; a Part A (if required), the relevant Part B section or sections, and all relevant amendments to the simplified prospectus (if necessary). In one embodiment, only information that is relevant to the purchase and has not previously been sent to the investor is included in the compliance information package provided to the investor.*

(Emphasis added). Further, as set forth in paragraph 23 of the specification:

By sending an investor only the information applicable to the investor's mutual fund purchase(s), there results an overall reduction in costs for both the mutual fund and the dealer. There are significantly reduced mailing costs, as only a portion of the entire prospectus is generated, which results in a lower mailing weight. Additionally, a "print on demand" (POD) service is used in one

embodiment to consolidate purchases of more than one mutual fund within an account into one mailing, thereby reducing the number of packages being mailed to investors. Further, by only printing documents when needed, the cost required to store and manage pre-printed inventory is also eliminated. ***The combination of confirmations of purchases with relevant portions of simplified prospectuses permits the number of mailings at the point of sale to be reduced.*** From the perspective of the mutual fund, there is an elimination, or great reduction, in the cost of commercially printing the prospectus. The present invention also allows the most up-to-date information to be sent to an investor as the information is generated specifically for the investor.

(Emphasis added).

The new limitations of claim 1 were originally set forth in claims 11 and 26 as originally filed. The Examiner did not find these claims to be anticipated by Burakoff et al. Because Burakoff et al. does not disclose, teach or suggest the use of trade identifiers for parts of investment documents, with use us having the benefit of allowing only parts of the investment documents to be provided to the investor, it is respectfully submitted that claim 1, as amended, is allowable, and the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Burakoff et al. is overcome.

Claims 2, 5-10, 12, 17, 18, 22-25, 28-31, and 33 Are Not Anticipated by Burakoff et al.

Claims 2, 5-10, 12, 17, 18, 22-25, 28-31, and 33 depend from and include all the limitations of claim 1. Because claim 1, as amended, is believed to be allowable, it is respectfully submitted that claims 2, 5-10, 12, 17, 18, 22-25, 28-31, and 33 are allowable, and the rejection of claims 2, 5-10, 12, 17, 18, 22-25, 28-31, and 33 under 35 U.S.C. § 102(b) is overcome.

Claim 34 Is Not Anticipated by Burakoff et al.

Claim 34, as amended, and like amended claim 1, now requires that the investor documents comprise "a plurality of parts with each of the plurality of parts defined with a trade identifier" and that step of determining investment information for the investor involves "use of the trade identifier of each of the plurality of parts of each of the identified document(s)". Because Burakoff et al. does not disclose, teach, or suggest such a limitation, and the Examiner did not assert that Burakoff et al. includes such a limitation, it is respectfully submitted that claim 34, as amended is allowable, and the rejection of claim 34 under 35 U.S.C. § 102(b) as being anticipated by Burakoff et al. is overcome.

Claim 35 Is Not Anticipated by Burakoff et al.

Claim 35 depends from and includes all the limitations of claim 34, as amended. Because claim 34 is believed to be allowable, it is respectfully submitted that claim 35 is allowable, and the rejection of claim 35 under 35 U.S.C. § 102(b) is overcome.

VI. The Rejection of Claims 3, 4, 20, and 21 Under 35 U.S.C. § 103(a) as Unpatentable over

Burakoff et al. in View of Bosarge et al. is Overcome

Claims 3, 4, 20, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burakoff et al. in view of Bosarge et al. Three factual determinations are required when evaluating whether or not a claimed invention is to be considered as obvious over the prior art: (i) the scope and content of the prior art; (ii) the differences between the prior art and the claims at issue; and (iii) the level of ordinary skill in the pertinent art. *Graham v. John Deere*, 383 U.S.

1, 17 (1966). As such, three criteria must be met to establish a *prima facie* case of obviousness: (i) there must be some suggestion or motivation to combine the teachings of two or more prior art references; (ii) there must be a reasonable expectation of success; and (iii) "***all of the claim limitations must be taught or suggested by the prior art.***" MPEP §§ 2142, 2143 and 2143.03 (emphasis added) (citing *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974); *see also In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991)). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP § 2143 (citing *In re Vaeck*, 947 F.2d at 493). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so that is found in the references themselves or is within the knowledge generally available to one of ordinary skill in the art. MPEP § 2143.01 (citing *In re Kotzab*, 217 F.2d 1365, 1370 (Fed. Cir. 2000); *see also In re Lee*, 277 F.2d 1338, 1342-44 (Fed. Cir. 2002); *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)).

Claims 3, 4, 20, and 21 depend from and include all the limitations of claim 1, as amended. As previously discussed, claim 1 now includes the limitations set forth in the original claims 11 and 26. The Examiner did not assert that either claim 11 or claim 26 were anticipated by or obvious in view of either Burakoff et al. or Bosarge et al., either alone or in combination.

Claim 3 is Patentable Over Burakoff et al. in View of Bosarge et al.

Claim 3 depends from and includes all the limitations of claim 1, as amended, and includes the limitations of trade identifiers for parts of documents which are used to determine the investment information to be provided to the investor,. The Examiner did not assert that such a limitation was anticipated by or obvious in view of either Burakoff et al. or Bosarge et al., either alone or in combination. Respectfully, neither reference discloses, teaches, or suggests such a limitation. Therefore, because claim 3 includes all the limitations of claim 1, as amended, and claim 1 is believed to be patentable over Burakoff et al. and Bosarge et al., it is respectfully submitted that claim 3 is also patentable and the rejection of claim 3 as unpatentable over Burakoff et al. in view of Bosarge et al. under 35 U.S.C. § 103(a) is overcome.

Claim 4 Is Patentable Over Burakoff et al. in View of Bosarge et al.

Because claim 4 depends from and includes all the limitations of claim 3, as amended, which is believed to be patentable, it is respectfully submitted that claim 4 is also patentable and the rejection of claim 4 as unpatentable over Burakoff et al. in view of Bosarge et al. under 35 U.S.C. § 103(a) is overcome.

Claims 20 and 21 Are Patentable Over Burakoff et al. in View of Bosarge et al.

Because claims 20 and 20 depend from and include all the limitations of claim 1, as amended, which is believed to be patentable, it is respectfully submitted that claims 20 and 21 are also patentable, and the rejection of claims 20 and 21 as unpatentable over Burakoff et al. in view of Bosarge et al. under 35 U.S.C. § 103(a) is overcome.

VII. The Rejection of Claims 13-16, 19, and 32 Under 35 U.S.C. § 103(a) as Unpatentable over Burakoff et al. in View of TD Canada Trust is Overcome

Claims 13-16, 19, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burakoff et al. in view of TD Canada Trust.

TD Canada Trust Does Not Qualify as Prior Art

The present application was filed based on a provisional patent application, and has a U.S. filing priority date of October 22, 2003. Respectfully, the art collectively referred to as TD Canada Trust does not qualify as prior art under 35 U.S.C. § 102. As stated in MPEP § 2141.01:

"Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.").

Because the TD Canada Trust art does not comprise a patent or a patent application, and the TD Canada Trust art is not asserted to disclose the invention, but rather is cited as contributing to obviousness, the applicable section of 35 U.S.C. to allow TD Canada Trust art to qualify as prior art is 35 U.S.C. § 102(b):

A person shall be entitled to a patent unless ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Pertinent to the references cited is whether the printed publications were printed more than one year prior to the date of application, namely, more than one year before October 22, 2003 (i.e., before October 22, 2002). The "TD Mutual Funds – Fund Profiles" article and the "TD Mutual Funds – Simplified Prospectus" article both have dates of October 2, 2003. These references were not printed before October 22, 2002, and therefore do not qualify as prior art. The TD Canada Trust website references do not contain a date. It is presumed that the Examiner has assumed that these website references may be from a date prior to October 22, 2002, but such assumption is not proper, even if the Examiner bases this assumption on what may be a date in the website link. Therefore, it is respectfully submitted that the Examiner improperly cited the TD Canada Trust art as prior art in the rejection of claims 13-16, 19, and 32 under 35 U.S.C. § 103(a).

Claims 13-16, 19, and 32 Are Patentable over Burakoff et al. in View of TD Canada Trust

Because the TD Canada Trust art does not qualify as prior art to the present application, it is respectfully submitted that the rejection of claims 13-16, 19, and 32 under 35 U.S.C. § 103(a) should be withdrawn. Even if the TD Canada Trust art were to be considered prior art, it is respectfully submitted that claims 13-16, 19, and 32 are still patentable. Claims 13-16, 19, and 32 depend upon and contain all the limitations of claim 1, as amended. Because claim 1 is believed to be patentable, it is respectfully submitted that claims 13-16, 19, and 32 are patentable and the rejection of claims 13-16, 19, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Burakoff et al. in view of TD Canada Trust is overcome.

CONCLUSION

For all the foregoing reasons, it is respectfully submitted that the Applicant has made a patentable contribution to the art and that this response places the above-identified application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested.

The present Response to the Office is being filed within three (3) months after the date of the Office Action. In the event the Applicant has inadvertently overlooked the need for an extension of time and/or for payment of an additional fee, the Applicant conditionally petitions therefor, and authorizes any fee deficiency to be charged to deposit account 09-0007.

Sincerely,

ICE MILLER LLP

A handwritten signature in black ink, appearing to read "Michael A. Swift / DJG".

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